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REMARKS

Claims 21-30 are currently pending in the present application. In this Amendment, Applicant has amended claims 21, 22, 25, 27 and 30. Reconsideration of the application in its present form is requested.

In the Office action, the Examiner has rejected claim 30 under 35 USC §101 because it is the Examiner's position that the claimed subject matter does not produce a tangible result. Presumably, the Examiner is applying the Office's "*Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*" (hereinafter the "Guidelines"). Applicant submits that the Guidelines are not in accord with established patent law, as has been pointed out by numerous commentators. For example, the distinction between "capable of" producing a "useful, concrete and tangible result" and "necessarily" producing it is not cognizable under the law. The Guidelines cite no current case law that supports a "necessarily" vs. "capable of" distinction, and the PTO lacks the authority to create new substantive law. *Merck & Co. v. Kessler*, 80 F.3d 1543, 1550, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996) (the PTO does "NOT ... have authority to issue substantive rules," emphasis the court's). Applicant submits that unamended claim 30 is fully "capable of" producing a useful, concrete and tangible result.

Notwithstanding the foregoing, Applicant submits that claim 30, as amended, produces a useful, concrete and tangible result.

The Examiner has rejected claims 21-30 under 35 U.S.C. §102(e) as being anticipated by Patent Application Publication No. 2005/0060048 to Pierre et al.

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Applicant notes that the Examiner has not applied the Pierre et al. application to the claims. Regardless, the Pierre et al. application fails to show or suggest most of the limitations of the claims of the subject application. For example, the Pierre et al. application fails to show or suggest the following limitations of independent claims 21 and 30:

"retrieving design data for said particular electrical device from said store of design data; using said design data to generate control data for controlling said at least one machine to manufacture said particular electrical device;" as recited in independent claim 21; and

"retrieving design data for said particular electrical device from said design data server; using said design data to generate control data for controlling said at least one machine to manufacture said particular electrical device;" as recited in independent claim 30.

For at least the foregoing reasons, Applicant submits that the Pierre et al. application fails to show or suggest independent claims 21 and 30 and, thus, dependent claims 22-29.

In the Office action, the Examiner is maintaining his rejection of claims 21-30 under 35 USC §103(a) as being unpatentable over U.S. Patent Application No. US2003/0014500 to Schleiss et al. In view of U.S. Patent No. 5,946,210 to Montminy et al. For purposes of brevity, Applicant will not repeat the arguments set forth in Applicant's Appeal Brief of November 15, 2006, but hereby incorporates these arguments by reference into this Amendment. Applicant, however, will address the

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Examiner's response to several of Applicant's arguments.

The Examiner states that "a recipe is a set of instructions for making or preparing something, and thus does indeed constitute "control data". Applicant submits that a "recipe" may, in a loose sense, be construed as control data for a *batch process*, i.e., a chemical process. The claims, however, require "control data for controlling said at least one machine to manufacture said particular electrical device". This is simply not disclosed in either the Schleiss et al. application or in the Montminy et al. patent.

The Examiner accuses the undersigned attorney of selectively omitting key data and not presenting a complete picture of the Schleiss et al. application. Applicant submits that this is not true. The undersigned attorney has tried to summarize the disclosure of the Schleiss et al. application in a complete, accurate and succinct manner. It is in Applicant's best interests to do so because such a summary best highlights the many differences between the claimed invention and the Schleiss et al. application. With regard to the passage cited by the Examiner, the undersigned attorney highlighted only a portion of the passage to succinctly make the point (with emphasis added) that "the term 'transactional data' *broadly* means asynchronous information". Applicant believes this is about as complete, accurate and succinct a definition of the term "transactional data" in the Schleiss et al. application that can be made. To avoid any further misunderstandings, however, Applicant has amended the claims to recite "business and manufacturing data" instead of "transactional data".

With regard to "transactional data", the point that Applicant is trying to make is that the Schleiss et al. application fails to show the specific steps of independent claims

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21 and 30 relating to the update of a store of business and manufacturing data with real-time information relating to the manufacture of an electrical device. The Examiner cites the abstract and paragraphs [0006], [0009]-[0014], [0023], [0035], [0038] and [0054] of the Schleiss et al. application as showing these steps. The paragraphs cited by the Examiner, however, only generally discuss the mechanics of communicating "transactional data" (broadly asynchronous data) within an enterprise. None of these paragraphs specifically show the update of a store of business and manufacturing data with real-time information about the manufacture of a device.

Based on the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 050877.

Respectfully submitted,

ABB Research Ltd.

By:



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